

## REMARKS

### I. Introduction

In the Office Action mailed on May 18, 2006, the United States Patent and Trademark Office (hereinafter "the Office") rejected Claims 25-31 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claims 25-31 are also rejected under 35 U.S.C. § 101 because independent Claim 25 describes computer memory including a data structure for storage and Claims 26-31 are rejected because they inherit the deficiencies of Claim 25.

Claims 1-12, 14-16, 18-37, and 39-48 are rejected under 35 U.S.C. § 102(e) as being anticipated by Keohane et al., U.S. Publication No. 2004/0187074. Claims 13, 17, 38, and 49-51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Keohane et al., in view of Deguchi, U.S. Publication No. 2003/0236711. With this amendment and response, Claims 1-3, 12-15, 17, 20-28, 32-36, and 38-51 remain pending in this application with Claims 1, 2, 3, 12, 15, 24, 25, 32, and 49 being independent claims. Claims 4-11, 16, 18-19, 29-31, and 37 have been canceled without prejudice. New Claims 56-65 have been added and no new matter has been introduced. Pursuant to 37 C.F.R. § 1.111 and for the reasons set forth below, applicants request reconsideration and allowance of this application. Prior to discussing the reasons why applicants believe that the present invention is in condition for allowance, an Examiner's Interview Summary is presented.

### II. Examiner's Interview Summary

Applicants thank the Examiner for taking time on August 1, 2006, to participate in a telephone interview. The interview was conducted in light of the Office Action rejecting Claims 1-51. Participating in the August 1, 2006, interview were Examiner Manglesh Patel and

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Examiner Cesar Paula, and applicants' representatives, Mauricio Uribe and Sunah Lee. The discussion in the interview was directed to the distinction between independent claims and the prior art, particularly the citation of an indicator that is modifiable based on a change of a web site and the indicator corresponds to the content of the web site to which an identified link points.

### **III. Rejections under 35 U.S.C. § 112 & 35 U.S.C. § 101**

Claims 25-31 were rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. However, with this response, Claims 25-28 have been amended to particularly point out and distinctly claim the subject matter. Applicants assert that, in regard to the 35 U.S.C. § 112, second paragraph, rejections, Claims 25-28 are in condition of allowance, and request that the 35 U.S.C. § 112, second paragraph, rejections be withdrawn. Rejections with respect to Claims 29-31 are now moot since Claims 29-31 have been canceled.

Further, the Office Action stated that Claims 25-31 were rejected under 35 U.S.C. § 101 because Claim 25 describes computer memory including a data structure for storage and Claims 26-31 inherit the deficiency of Claim 25. However, with this response, Claims 25-28 have been amended to describe a system for storing and tracking user activities in web sites. Applicants assert that, in regard to the 35 U.S.C. § 101 rejections, Claims 25-28 are in condition of allowance, and request that the 35 U.S.C. § 101 rejections be withdrawn. Rejections with respect to Claims 29-31 are now moot since Claims 29-31 have been canceled.

### **IV. Rejections Under 35 U.S.C. § 102**

The Office Action rejected Claims 1-12, 14-16, 18-37, and 39-48 under 35 U.S.C. § 102(e) as being anticipated by Keohane et al. The Office Action asserts that Keohane et al.

discloses each and every element of the claims. As described in more detail below, applicants respectfully disagree.

A. Independent Claim 1

In its amended form, Claim 1 recites:

1. (Currently amended) A method in a computing system for highlighting links to web sites that are of interest to a user, comprising:

displaying a first web page requested by a user from a web site;

receiving an indication from the user that the web site is of interest to the user;

in response to the indication from the user that the web site is of interest to the user:

determining the identity of the web site from the URL of the first web page, and

storing an entry corresponding to the web site in a list of web sites of interest;

at a time after the storing, receiving a request by the user for a second web page;

identifying within the second web page a link that points to the web site specified by the stored entry in the list of web sites of interest;

modifying the second web page to indicate that the identified link points to a web site of interest to the user and an indicator associated with the identified link, the indicator representing content of the web site that corresponds to the identified link;

wherein the indicator is modified in response to a change in the content of the web site; and

displaying the second web page as modified.

Claim 1 recites a method for highlighting links to web sites that are of interest to the user.

As recited in Claim 1, the method specifically requires "identifying within the second web page a link that points to the web site specified by the stored entry in the list of web sites of interest" and "modifying the second web page to indicate that the identified link points to a web site of interest to the user and an indicator associated with the identified link, the indicator representing

content of the web site that corresponds to the indicated link." The method recited in Claim 1 further requires that "the indicator is modified in response to a change in the content of the web site."

**Keohane et al. Fails to Disclose "the Indicator is Modified in Response to a Change"**

Simply stated, Keohane et al. does not teach or suggest an indicator that represents content of the web site and that can be modified in response to a change in the content of the web site as recited in Claim 1. Instead, Keohane et al. merely teaches "a small indicator, such as a book image" next to hyperlink in order to "visually distinguish such previously bookmarked hyperlinks." (Paragraph [0008].)

As described in Keohane et al., "the URLs of the bookmarked document have been stored in a list and as the present web page has been accessed for display, the URL of the hyperlinks therein have been compared to the user's URL list of bookmarked documents and those hyperlinks 72 representative of **previously bookmarked web pages have been indicated by an indicator 73 symbol in the form of a book image.** (Emphasis added.) (Paragraph [00024].) Thus, applicants respectfully submit that the indicator for visually distinguishing previously bookmarked hyperlinks as disclosed in Keohane et al. is fundamentally different from the indicator for representing contents of a web site that is modified in response to a change in the web site, as recited in Claim 1. Specifically, in Keohane et al., the indicator is not displayed to represent contents of a web site that has been previously bookmarked. Instead, in Keohane et al., "an indicator" is a single indicator having a book image that is used to distinguish a previously bookmarked hyperlink over other hyperlinks which are not yet bookmarked. Applicants assert that implementing a single indicator for several bookmarked hyperlinks is nothing more than highlighting the bookmarked hyperlinks. For example, Keohane et al. discloses "alternatively at the hyperlink may be highlighted to indicate the previous bookmarking." (Paragraph [0008].)

Accordingly, Keohane et al. fails to teach or suggest "an indicator representing content of the web site that corresponds to the identified link wherein the indicator is modified in response to a change in the content of the web site" as recited in Claim 1.

Applicants respectfully submit that Keohane et al. fails to expressly or inherently teach, disclose, or suggest each and every element of Claim 1. Accordingly, for this reason, applicants respectfully submit that the amended Claim 1 is now allowable.

B. Independent Claim 2

In its amended form, Claim 2 recites:

2. (Currently amended) A method in a computing system for identifying links to web sites that are of interest to a user, comprising:
  - displaying a first web page;
  - displaying a web site selection control in conjunction with the first web page;
  - in response to activation of the web site selection control by the user while the first web page is displayed:
    - creating a new entry corresponding to the first web page in a list of web sites of interest,
      - identifying a web site containing the first web page, and
      - storing in the created entry information specifying the identified web site;
    - at a time after the storing, receiving a request for a second web page;
    - identifying within the second web page a link that points to the web site specified by the created entry;
    - modifying the second web page to indicate that the identified link points to a web site of interest and an indicator associated with the identified link, the indicator corresponding to content of the web site to which the identified link points, the content of the web site being obtained from a part of the web site of interest that is distinct from the part of the web site to which the identified link initially points;
    - wherein the indicator is modified in response to a change request from the web site; and
    - displaying the second web page as modified.

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In a similar manner to Claim 1, Claim 2 is directed to a method for identifying links to web sites that are of interest to a user. As claimed in Claim 2, the method specifically recites "identifying within the second web page a link that points to the web site specified by the creative entry" and "modifying the second web page to indicate that the identified link points to a web site of interest and an indicator associated with the identified link, **the indicator corresponding to content of the web site to which the identified link points, ... the indicator is modified in response to a change request from the web site.**" (Emphasis added.) For similar reasons as stated with regard to Claim 1, Keohane et al. fails to disclose "the indicator corresponding to content of the web site to which the identified link points" and "the indicator is modified in response to a change request from the web site," as recited in Claim 2.

Further, the method claimed in Claim 2 recites "the content of the web site being obtained from a part of the web site of interest which is distinct from the part of the web site to which the identified link initially points," which Keohane et al. also fails to disclose. Contrary to the claimed invention, an indicator in Keohane et al. is merely attached to the hyperlink which points to the web page a user wants to remember (bookmark). Thus, at best, the indicator in Keohane et al. corresponds to the URL of the web page (i.e., the web page to which the hyperlink initially points) but it does not correspond to content from the web pages that are "distinct from" the web page "to which the identified link initially points," as recited in Claim 2. Thus, applicants respectfully submit that Keohane et al. fails to expressly or inherently teach, disclose, or suggest each and every element of Claim 2. For the reasons set forth above, applicants respectfully submit that amended Claim 2 is now allowable.

### C. Independent Claim 3

In its amended form, independent Claim 3 recites:

3. (Currently amended) A method in a computing system for identifying links to web sites that are of interest to a user, comprising:

for each link in a web page requested by a user, determining whether the link points to a web site specified by any entry in a list of web sites of interest;

for each link in the web page determined to point to a web site specified by any entry in a list of web sites of interest, modifying the web page to identify the link as pointing to a web site of interest, the link being attached to at least one indicator for the web site;

displaying the requested web page as modified;

configuring the at least one indicator to be modifiable while the requested web page is being displayed,

wherein the at least one indicator is indicative of content targeting the user, the content being obtained from the web site of interest;

displaying a web site selection control in conjunction with the requested web page; and

if the user activates the web site selection control while the requested web page is displayed:

identifying a web site containing the requested web page, and

storing a new entry containing the identified web site in the list of web sites of interest.

In a similar manner to Claims 1 and 2, Claim 3 recites a method for identifying links to web sites that are of interest to a user. As claimed in Claim 3, the method specifically recites "modifying the web page to identify the link as pointing to a web site of interest, the link being attached to at least one indicator for the web site" and "configuring the at least one indicator to be modifiable while the requested web page is being displayed." Further, the method recites "the at least one indicator is indicative of content targeting the user, the content being obtained from the web site of interest." For similar reasons as those stated above with regard to Claim 1, Keohane et al. fails to teach "an indicator" that is "modifiable while the requested web page is being displayed" and that is "indicative of content targeting the user, the content being obtained from the web site of interest," as recited in Claim 3. Accordingly, applicants respectfully request that amended Claim 3 be allowed.

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D. Independent Claim 12

In its amended form, Claim 12 recites:

12. (Currently amended) A method for processing a web page, comprising:

receiving the web page;

determining whether the web page is part of a web site identified in a list of web sites indicated to be of interest;

if the web page is part of a web site identified in a list of web sites indicated to be of interest, displaying the web page in a manner that indicates that the web page is part of a web site indicated to be of interest, the web page including at least one indicator corresponding to content of the part of the web site indicated to be of interest, and

wherein the at least one indicator is dynamically changeable based on the content of the part of the web site.

In a similar manner to Claim 1, Claim 12 recites a method for processing a web site that includes identified links to web sites that are of interest to a user. As claimed in Claim 12, the method specifically recites "if the web page is part of a web site identified in a list of web sites indicated to be of interest, displaying the web page in a manner that indicates that the web page is part of the web site indicated to be of interest," and "the web page including at least one indicator corresponding to content of the part of the web site indicated to be of interest, and wherein the at least one indicator is dynamically changeable based on the content of the part of the web site." For similar reasons as those stated above with regard to Claims 1 and 3, Keohane et al. fails to disclose or suggest at least one indicator corresponding to content of the part of the web site indicated to be of interest wherein the at least one indicator is dynamically changeable based on the content of the part of the web site as recited in Claim 12. Accordingly, applicants respectfully request that amended Claim 12 be allowed.

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E. Dependent Claim 14

Claim 14 is dependent on Claim 12 and thus allowable for the reasons discussed above in connection with Claim 12. Claim 14 also includes a myriad of recitations not disclosed, taught, or suggested by any of the cited and applied references, particularly when the recitations are considered in combination with the recitations of Claim 12 from which this claim depends.

F. Independent Claim 15

In its amended form, independent Claim 15 recites:

15. (Currently amended) A method in a computing system for tracking web sites, comprising:

displaying in conjunction with a browser window a control for indicating interest in web sites;

receiving an indication that a user has activated the control during the display of a distinguished web page in the browser window;

in response to receiving the indication:

identifying a web site with which the distinguished web page is associated;

adding the identified web site to a list of web sites that have been indicated by the user to be of interest;

when a link to a web page associated with the identified web site is displayed in the browser window at a time after the adding, attaching a dynamic indicator to the displayed link; and

wherein the dynamic indicator represents content from the identified web site and changes in response to any change in the content while the link to the web page is being displayed.

In a similar manner to Claim 1, Claim 15 recites a method for tracking web sites. As claimed in Claim 15, the method specifically recites "identifying a web site with which the distinguished web page is associated" and "adding the identified web site to a list of web sites that have been indicated by the user to be of interest." Further, the method recites "attaching a **dynamic indicator** to the displayed link," and "**the dynamic indicator represents content** from the identified web site and **changes in response to any change** in the content while the link to

the web page is being displayed." (Emphasis added.) For the similar reasons as so stated above with regard to Claim 1, Keohane et al. fails to disclose or suggest "attaching a dynamic indicator to the displayed link; and wherein the dynamic indicator represents content from the identified web site and changes in response to any change in the content while the link to the web page is being displayed." Accordingly, applicants respectfully request that amended Claim 15 be allowed.

G. Dependent Claims 20-23

Claims 20-23 are dependent on Claim 15 and thus allowable for the reasons discussed above in connection with Claim 15. Claims 20-23 also include a myriad of recitations not disclosed, taught, or suggested by any of the cited and applied references, particularly when the recitations are considered in combination with the recitations of claims from which these claims depend.

H. Independent Claim 24

In its amended form, independent Claim 24 recites:

24. (Currently amended) A computer-readable medium whose contents cause a computing system to track web sites by:

    during the display of a distinguished web page in the browser window, receiving a user input event associated with a web site tracking command;

    in response to receiving the user input event:

        identifying a web site with which the distinguished web page is associated;

        adding the identified web site to a list of web sites that have been selected for tracking by a user;

        when a link to a web page associated with the identified web site is displayed in the browser window at a time after the adding, identifying and displaying an indicator for the link, the indicator being indicative of advertising content of the identified web site; and

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updating the indicator in response to a change in the advertising content.

In a similar manner to Claim 1, Claim 24 recites a computer-readable medium whose contents cause a computing system to track web sites. As claimed in Claim 24, the computer-readable medium specifically recites "identifying and displaying an indicator for the link, the indicator being indicative of advertising content of the identified web site" and "updating the indicator in response to a change in the advertising content."

For the similar reasons as so stated above with regard to Claim 1, Keohane et al. fails to disclose or suggest "identifying and displaying an indicator for the link, the indicator being indicative of advertising content of the identified web site" or "updating the indicator in response to a change in the advertising content." Accordingly, applicants respectfully request that amended Claim 24 be allowed.

I. Independent Claim 25

25. (Currently amended) A system for storing and tracking user activities in web sites, comprising:

a user-interest component, the user-interest component comprising a plurality of entries, each entry identifying a web site explicitly indicated by a user to be of interest during the display of a web page within the identified web site, the entry not identifying the web page within the identified web site,

such that the contents of the user-interest component are used to highlight displayed information that relates to a web site identified by one of the entries and display a visual indicator, the visual indicator being dynamically modified to represent a promotion offer from the web site identified by one of the entries.

In a similar manner to Claim 1, Claim 25 recites a system for storing and tracking user activities in web sites. As claimed in Claim 25, the system recites "display a visual indicator, the visual indicator being dynamically modified to represent a promotion offer from the web site identified by one of the entries," which Keohane et al. fails to teach. For the similar reasons as

so stated above with regard to Claim 1, Keohane et al. fails to disclose or suggest each limitation recited in Claim 25. Accordingly, applicants respectfully request that amended Claim 25 be allowed.

J. Dependent Claim 26

Claim 26 is dependent on Claim 25 and thus allowable for the reasons discussed above in connection with Claim 25. Claim 26 also includes a myriad of recitations not disclosed, taught, or suggested by any of the cited and applied references, particularly when the recitations are considered in combination with the recitations of Claim 25 from which this claim depends.

K. Independent Claim 32

In its amended form, Claim 32 recites a method for analyzing a search result comprised of a set of entries each corresponding to a web site in a similar manner to Claim 1. As claimed in Claim 32, the method specifically recites "adding to the entry **an icon representing content** related to the web site to which the entry corresponds, **the icon being updated** after negotiating with the web site with respect to the content," which Keohane et al. fails to teach. Accordingly, Claim 32 should be allowable.

L. Dependent Claims 33-36 and 39-48

Claims 33-36 and 39-48 are dependent on Claim 32 and thus allowable for the reasons discussed above in connection with Claim 32. Claims 33-36 and 39-48 also include a myriad of recitations not disclosed, taught, or suggested by any of the cited and applied references, particularly when the recitations are considered in combination with the recitations of the claims from which these claims depend.

V. Rejections Under 35 U.S.C. § 103

Claims 13, 17, 38, and 49-51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Keohane et al., in view of Deguchi.

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To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). See also *In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

Further, to establish a proper rejection under 35 U.S.C. § 103, M.P.E.P. § 2143 states that

Three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (Emphasis added.) (M.P.E.P. § 2143.)

If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. (Emphasis added.) *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

As a preliminary matter, applicants note that Claim 13 depends from independent Claim 12. Accordingly, applicants respectfully submit that Claim 13 is allowable for the reasons described above in regard to Claim 12. In addition, Claim 17 depends from independent Claim 15 and is also submitted to be allowable for the reasons described above in regard to Claim 15. Similarly, Claim 38 depends from independent Claim 32 and is submitted to be allowable for the reasons described above in regard to Claim 38.

Moreover, Claims 13, 17, and 32 also include a myriad of recitations not disclosed, taught, or suggested by any of the cited and applied references, particularly when the recitations are considered in combination with the recitations of the claims from which these claims depend. For example, Claims 13, 17, and 32 recite additional limitations which are not taught or suggested by any of the cited and applied references, either alone or in combination thereof.

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A. Dependent Claims 13, 17 and 32

Claim 13 recites "the displaying comprises displaying within the web page the at least one indicator corresponding to a promotion from the web site, the promotion not being received with the web page." The present Office Action relies on Deguchi for teaching promotional offers related to bookmarked items. However, Deguchi is limited to teaching an **e-marker dot promotion system** for providing a discount promotion for **marked music clips** such as music CDs. As disclosed in Deguchi, the e-marker dot promotion system merely transmits the retrieved and identified coupon information to the user terminal. More specifically, the e-marker dot promotion system in Deguchi transmits coupon information "to user terminal 103 in a graphical format, a text format or a combination of graphical and text format including a selectable 'dot' icon which is displayed on the user terminal 103 display unit" (Deguchi, Paragraph [0075].) Contrary to the claimed invention, the "dot icon" included in the coupon information (promotion coupon) is merely displayed to "be selected using an input device such as a keyboard, a mouse, or a stylus at user terminal 103" **for selecting the promotion coupon.** Applicants respectfully submit that the "dot icon" included in the coupon information is not equivalent to "an indicator" that corresponds to "a promotion from the web site, the promotion not received with the web page," as recited in Claim 13. Thus, Deguchi fails to teach or suggest "the displaying comprises displaying within the web page the at least one indicator corresponding to a promotion from the web site, the promotion not being received with the web page."

For the above reasons, applicants respectfully submit that all the claim limitations in Claim 13 are not taught or suggested by any of the cited and applied references and thus *prima facie* obviousness with respect to Claim 13 has not been established.

In a similar manner to Claim 13, Claim 17 recites "displaying the dynamic indicator representing a promotion for the identified web site in conjunction with the link," and Claim 38

recites "the search result is modified by, for each entry corresponding to a web site included in the list, adding to the entry the icon representing a promotion for the web site to which the entry corresponds." For the similar reasons as so stated above with regard to Claim 13, Deguchi in view of Keohane et al. fails to disclose or suggest each limitation recited in Claims 17 and 38.

B. Independent Claim 49

Independent Claim 49 recites a method for selectively presenting promotional offers with respect to a subject web site. The method specifically requires "when a page of the subject web site is displayed, receiving user input identifying the web site to which the page belongs as being of interest" and "in response to receiving the user input, displaying a promotional offer for the subject web site." Further, the method recites that "the promotional offer is represented via a visual indicator which is modified in response to a change in the promotional offer."

For similar reasons as stated with regard to Claim 1, Keohane et al. failed to disclose "the promotional offer is represented via a **visual indicator** which is **modified in response to a change in the promotional offer.**" (Emphasis added.) Further, Deguchi does not make up the defects of Keohane et al. because Deguchi is limited to an e-marker dot promotion system for providing coupon information for marked music clips such as music CDs. Deguchi fails to teach that the coupon information is updated while the coupon information is being displayed. The coupon information (promotion coupon) in Deguchi is retrieved only at the time when the user logs in. Even if applicants assume that Deguchi's teaching of a promotion coupon with Keohane et al.'s teaching of an indicator can be combined, at best the combination would result in a system where the promotion coupon relating to a bookmarked link may be displayed but, once displayed, the promotion coupon will not change in response to the changes in the bookmarked web page. For these reasons, Deguchi in view of Keohane et al. fails to disclose or suggest each limitation recited in Claim 49. Accordingly, applicants respectfully request that amended Claim 49 is now allowable.

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C. Dependent Claims 50 and 51

Claims 50 and 51 are dependent on Claim 49 and thus allowable for the reasons discussed above in connection with Claim 49. Claims 50 and 51 also include a myriad of recitations not disclosed, taught, or suggested by any of the cited and applied references, particularly when the recitations are considered in combination with the recitations of the claims from which these claims depend.

**VI. Conclusion**

In view of the foregoing remarks, applicants submit that all pending claims are in patentable condition and respectfully request an early notice to that effect. The Examiner is requested to contact applicants' attorney at the number provided below should any questions or issues remain.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

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